

REMARKS

The applicants have reviewed the Official Action mailed by the Office on 3 October 2003 and the art cited therein. The applicants submit this paper as a fully-responsive and timely-filed response to this Official Action, and request entry and consideration of this response.

5 Paragraph 3 of the Official Action rejected claims 21, 22, 36, 39, 40, 42-46, 50, 68-71, and 75 as being anticipated under § 102(b) by Malec.

MPEP § 2131 provides as follows, relating to rejections based on anticipation:

10 "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02.< "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a **35 U.S.C. 102** rejection." (emphasis added)

The applicants respond to the § 102 rejections of the above claims as follows.

1. The applicants submit that Malec does not disclose primary transactions that are
25 initiated by users.

The applicants quote from independent claim 21, with emphasis added here:

"establishing communication via the electronic communications device between the offeror and the user to enable the user at least to initiate a primary transaction therebetween".

Independent claim 68 recites a similar feature.

30 The Official Action cited column 5, lines 7-22 of Malec as disclosing primary transactions as that term is used in the applicant's claims and specification. This portion

of Malec, along with Figure 4 and the related discussion, describes a process by which a series of messages are formulated and then loaded onto several shopping carts 500 via a store message transceiver 503. These messages appear to be pre-defined or static (once loaded) in nature, in that a respective message for each respective section of the store 107 is formulated for subsequent display to each customer that pushes a cart 500 through that section. SCD electronics 514 aboard the carts 500 store these messages in a memory for later retrieval and display of selected messages, as discussed below.

Malec's store 107 is provided with a plurality of trigger transmitters 512, each of which is assigned a unique identifier or address. One or more of the trigger transmitters 512 can be deployed in respective areas of the store 107, such that the unique identifier or address of a given trigger transmitter 512 then becomes associated with the location of the store 107 where the given trigger transmitter is deployed. The set of messages loaded onto each cart 500 appears to be indexed by this unique address, thus linking each message with a respective section of the store 107. Each of the trigger transmitters 512 radiates a signal representing its unique identifier from the transmitter's respective location in the store 107. As a shopper moves a cart 500 around the store, that cart may pass sufficiently near one or more of the trigger transmitters 512 to receive the signal radiated therefrom. If so, the SCD electronics 514 aboard that cart extracts the unique identifier from the received signal and locates the message associated with that unique identifier as stored previously in the SCD electronics 514. The SCD electronics 514 then displays the located message to the shopper. Thus, for example, when the shopper passes the bread aisle, a message pertaining to a sale price on a particular brand of bread might be displayed to the shopper.

Turning to the excerpts quoted above from the applicants' claims 21 and 68, the applicants respectfully submit that Malec fails to disclose at least the emphasized feature, and therefore respectfully traverse the § 102(b) rejection as being unsupported by Malec under the MPEP section cited above. To the extent that the above processing by Malec is considered to disclose "primary transactions", as that term is used in the applicants' claims and specification, the applicants respectfully submit that this primary transaction is not initiated by the user, as recited in claims 21 and 68, but is initiated instead by the signals radiating from each of the trigger transmitters provided by Malec. Malec's

shopper merely pushes his or her cart 500 around the store as usual, taking no particular action intended to initiate the messages displayed by the Malec system. While Malec's shopper may respond to the messages (e.g., by selecting the bread that is on sale and placing it in the cart), the applicants submit that the Malec system initiated or "pushed" this transaction, not the shopper. In Malec, the shopper plays a relatively passive role in these "transactions". In contrast, claims 21 and 68 recite a primary transaction that is essentially initiated or "pushed" by the user. In the method recited in the applicants' claims, the user plays a more active role in the primary transaction.

On at least this basis, the applicants submit that the § 102 rejection as stated in the Official Action is not supported by Malec, and thus should be reconsidered and withdrawn.

2. *To the extent that the messages displayed on the Malec shopping carts in response to signals from Malec's triggering transmitters are considered "primary transactions", the data comprising these signals does not include data identifying the shopper.*

The applicants quote the following from claim 21, with emphasis added:

"obtaining primary transaction data related to the primary transaction, *the primary transaction data including at least data representing an identity of the user* and data representing a geographic position of the user,"

The applicants respectfully submit that, to the extent that the messages displayed on the Malec shopping carts in response to signals from the triggering transmitters are considered "primary transactions", as that term is used in the applicants' claims the data comprising or relating to these signals does not include data identifying the shopper. As discussed above, in Malec, the data comprising the messages displayed to the shoppers are transmitted from the SCD in-store computer 502 to the carts 500 via the SMT 503. While the data comprising these messages may originate either locally in the given store 107 (e.g., store specials, greetings, displays, or the like formulated by a local store manager) or remotely at a central studio 103 (see Figure 1), this data does not appear to include data identifying the shoppers whom may later shop in the store 107. Further, it is unclear how identification data for potential shoppers would be available when these pre-defined messages are created. While Malec appears to discuss extracting personal data, including demographic data and perhaps including identification data,

from smart cards presented by shoppers (Malec, column 24, lines 40-56), this appears to be the only means by which Malec can identify the shopper, and this identification appears to occur well after Malec's pre-existing messages are formulated and loaded into the carts 500. However, to the extent that data extracted from the smart cards includes identification data, that data does not appear to be used "to obtain at least a further data element related to the user" (independent claim 21). Thus, Malec fails to meet the feature quoted above on at least this basis.

Moreover, Malec does not specify the role, if any, played by the identification and/or demographic data extracted from the smart cards in displaying the messages on the cart display electronics 514. While Malec discusses in column 24, lines 53-55 that Malec can "target different advertisements to this cart based on the demographic information", this passage and Malec overall appears to be silent as to whether the shopper's identity data or demographic data is affirmatively communicated to the overall Malec system (e.g., to the SCD store computer 502) to be included as part of subsequent messages, or whether this data resides locally in the cart display electronics 514 to serve as some type of filter to be applied against messages stored previously in such electronics 514. Accordingly, to the extent that any data flows from the respective carts 500 to the Malec system, the applicants submit that Malec fails to disclose that this data flow (assuming this data flow is "primary transaction data" as recited in the applicants' claims and specification) includes any data identifying the user. Extending the above first set of comments, Malec's primary transactions appear to be "pushed" by the Malec system largely irrespective of the shopper's identity, while the primary transactions recited in the applicants' claims are essentially "pushed" by the user, with data representing the user's identity being part of the data obtained as part of these primary transactions.

3. *New claims 198-205 recite additional aspects of primary transactions that are not shown by Malec.*

Further to clarify the applicants' invention, the applicants have added new claims 198-200 depending from independent claim 21. Claim 198 recites that the primary transaction is for a particular good or service sought by the user. The applicants submit that claim 198 is fully supported by the originally-filed specification at least at page 34, line 34. The applicants further submit that Malec does not disclose a primary transaction for an item sought by the user. Instead, the messages triggered by the Malec shopper

when approaching Malec's trigger transmitters and displayed on Malec's shopping carts pertain generally to items that are proximate to a given trigger transmitter. These messages appear to be displayed to each shopper whose cart approaches the given transmitter, irrespective of whether a given shopper is actually seeking those particular items.

New claim 201 corresponds substantially to new claim 198, but depends from independent claim 68.

New claim 199 depends from independent claim 21 and recites a primary transaction initiated by the user providing data to a system. The applicants submit that claim 199 is fully supported by the originally-filed specification at least at page 13, line 26. The applicants further submit that Malec does not disclose a primary transaction initiated by the user providing data to a system. Instead, Malec's display of messages to shoppers appears to be initiated or "pushed" by the Malec system, particularly by the transmissions radiated from Malec's various triggering transmitters. Assuming that these messages are considered "primary transactions", these messages are initiated by a data flow from the Malec system (i.e., the triggering transmitters) to the shopper, rather than a data flow from the user to a system, as recited in new claim 199.

New claim 202 corresponds substantially to new claim 199, but depends from independent claim 68.

New claim 200 depending from independent claim 21 essentially recites the features recited by both new claims 198 and 199, and the comments above regarding those two claims are equally applicable to claim 200.

New claim 203 corresponds substantially to new claim 200, but depends from independent claim 68.

New claims 204 to 207 add the further limitation to independent claims 21 and 68 that the data representing the geographic position of the user is electronically communicated from the user to the offeror system. Claims 205 and 207 specify that the data is communicated prior to determination of the offer. At best, Malek transfers data to

the offeror after the targeted marketing offer has been made. (See, e.g., Malec col. 9, line 1 et seq.).

The applicants believe no additional claims fees are necessitated by these new claims, and request entry and consideration of these new claims.

- 5 4. *To the extent that previous customer transactions as represented in the demographic data retrieved from the shopper's smart card according to Malec are considered "primary transactions", those previous transactions do not occur in real time with the items, discounts, loyalty points, or coupons offered to the shoppers in the store as taught by Malec.*

The applicants quote the following as recited in independent claim 21:

- 10 "utilizing at least in part the geographic position of the user, the at least further data element, and the identity of the user to determine the at least one offer for the item in real time with the primary transaction," (emphasis added),

and quote the following as recited in independent claim 68:

- 15 "utilizing at least in part the geographic position of the user and the at least further data element to determine the at least one offer for the item in real time with the primary transaction" (emphasis added).

- 20 To the extent that the term "primary transactions" as used in the applicants' claims and description is considered to correspond to the previous transactions that are represented on Malec's smart card, the applicants submit that Malec does not determine or identify "items" in real time with these "primary transactions." Turning to Malec in more detail, in column 24, lines 40-56, Malec describes a process of reading, via an input device 1303, a "personal data base" for a given customer from a smart card presented by the customer. In column 24, lines 45-49, Malec lists various examples of the types of "personal" or "demographic" data pertaining to the given customer that the Malec system might read via this input device 1303. This passage also
- 25 discusses offering coupons, advertisements, or loyalty points based on this data. Meanwhile, in column 5, line 16, Malec describes displaying a message to the customer when the cart 500 is in the proximity of a trigger transmitter 512, with the message being displayed either "immediately" or after a time delay.

Even assuming, only for the sake of these comments, that:

1. previous transactions formed the basis for the demographic or other personal data that are stored on the smart card (Malec, column 24);
2. these previous transactions correspond to “primary transactions” as recited in the applicants’ claims and specification;
- 5 3. the display of messages, printing of coupons, or offer of loyalty points to the customer (Malec, column 24) when he/she approaches a trigger transmitter 512 (Malec, column 5) correspond to “items” as recited in the applicants’ claims and specification; and
- 10 4. the messages, coupons, or loyalty points are presented “immediately” or soon after a shopper approaches the transmitter,

the applicants respectfully submit that this teaching from Malec does not meet the features emphasized in the above claims. The previous transactions (“primary transactions”) providing the personal or demographic data extracted from Malec would occur some time before the shopper enters the grocery store, and thus necessarily well before the shopper would receive

15 messages, coupons, or loyalty points (“items”) selected based on extraction of that personal or demographic data. Accordingly, Malec’s version of an “item” is not determined in real time with the “primary transaction”, as recited in the claims above. While Malec’s messages, coupons, or loyalty points may be presented “immediately” or soon after a shopper approaches the trigger transmitter, these messages, coupons, or loyalty points do not appear to be presented

20 “immediately” or soon after the occurrence of the primary transaction that indicates which messages, coupons, or loyalty points should be presented to the shopper.

On at least this basis, the applicants respectfully submit that the § 102 rejection of claims 21, 22, 36, 39, 40, 42-46, 50, 68-71, and 75 is improper under the MPEP because Malec fails to teach determining an item for offer to the user in real time with a primary transaction, as

25 discussed above. Thus, the § 102 rejection of these claims should be reconsidered and withdrawn.

The remaining claims pending in the case depend ultimately from the independent claims discussed above, and thus the above comments apply equally to these remaining claims.

The applicants request favorable action at the earliest convenience of the Office. If discussion of this application or this response would advance prosecution of the instant application, the Office is requested to contact Rocco Adornato at the telephone number indicated below.

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Respectfully submitted,

WEST CORPORATION

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